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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/559,967	12/07/2005	Luca Morlacchi	1029.1029	6542
20311 7590 12/30/2009 LUCAS & MERCANTI, LLP 475 PARK AVENUE SOUTH 15TH FLOOR NEW YORK, NY 10016				
EXAMINER AZIZ, KETHI T				
ART UNIT		PAPER NUMBER		
1791				
NOTIFICATION DATE		DELIVERY MODE		
12/30/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

info@lmiplaw.com

Office Action Summary

Application No.

10/559,967

Applicant(s)

MORLACCHI, LUCA

Examiner

KEITH T. AZIZ

Art Unit

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 51-53 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 51-53 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____
- Paper No(s)/Mail Date ____

DETAILED ACTION

1. Claims 1-11, and 50-53 are pending as amended on 9/14/2009, claim 12 having been cancelled, and claims 14-49 having been previously withdrawn.
2. The rejection of claims 1-3 under 35 U.S.C. 102(b) as anticipated by Morlacchi has been withdrawn, in view of amendments made to the claims on 9/14/2009.
3. The objection of claims 2 and 3 is withdrawn.
4. The objection of claims 4-12 under 37 CFR 1.75(c) as being in improper form due to multiple dependency is withdrawn.

Response to Amendment and Arguments

5. Applicant's arguments, see applicant remarks, filed 9/14/2009, with respect to the rejection(s) of claim(s) 1-3 under 35 U.S.C. 102(b) have been fully considered and are persuasive, in view of the amendments made to the claims. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made as is seen below.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 1-11, and 51-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morlacchi, in view of U.S. Patent 5,983,524 (Polegato hereafter).

Morlacchi discloses a process and device for water-proofing semi-manufactured articles (see title, as well as Abstract). Morlacchi teaches that a semi-manufactured with a three dimensional shape and an inner and outer surface (see lines 7-9 of page 3) is arranged onto a shaped support (see lines 18-22 of page 3). Morlacchi also teaches at least one waterproofing sheet with a layer of glue arranged between the sheet and the product is used to cover the product (see lines 27-30 of page 3). Morlacchi further teaches that the product, which is arranged around the shaped support, is water-proofed through pressing the waterproof sheet between two deformable pressing plates (see lines 16-19 of page 2, as well as Figures 6 and 7). Morlacchi teaches that the waterproof sheets are folded and flattened if they extend beyond the size of the semi-manufactured product (see lines 7-9 of page 2), and that after folding the sides adhere to one another to form at least two strips that seal the product during pressing (see lines 10-13 of page 2). While Morlacchi does not explicitly state that the waterproof sheets are shaped in a three-dimensional conformation similar to that of the product, the shape

of the folded waterproof sheet would implicitly be similar to the shape of the product and possess three dimensions. All objects with a length, width and height possess three dimensions, and the waterproof sheets inherently have a length, width and height. Additionally, as the waterproofing sheets are being placed on the product on the shaped support, the sheets would inherently have the same or similar shape to the semi-manufactured product. Morlacchi does not explicitly teach that the semi-permeable membrane is cut, folded, or welded together by superimposing two edges.

Polegato discloses a vapor permeable shoe and a method of making the vapor permeable shoe. Polegato teaches that a vapor permeable membrane is cut so that it is larger than the upper portion of the shoe (see lines 14-16 of column 4). The upper portion of the shoe is implicitly smaller than the entire inner surface of the shoe (see Figure 2), and since Polegato teaches that the membrane must be larger than the upper, the size to which the membrane is cut may implicitly be the size of the inside of the shoe. Polegato further teaches that the membrane is folded and that the edges are welded along the perimeter of the membrane (see lines 6-13 of column 4). When two edges are welded, a single sheet is implicitly formed, and it also implicitly has a third dimension. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the processes of Polegato in the process of Morlacchi. The rationale to do so would have been the motivation to provide an article that has an optimum internal microclimate (see lines 30-35 of column 1).

With regard to claim 2, Morlacchi teaches that the glue is a thermoactive glue (see lines 29-30 of page 3) and that the glue is heated during pressing (again, see lines

29-30 of page 3). Morlacchi further teaches that the glue joins the waterproof sheets to the semi-manufactured product (see lines 30-31 of page 3, as well as lines 1-2 of page 4).

With regard to claim 3, Morlacchi teaches that the three dimensional semi-manufactured product is turned 'inside-out', such that the inner surface is turned outwards (see lines 6-10 of page 3).

With regard to claims 4 and 6, Morlacchi teaches that the shaped support is expandable (see lines 21-22 of page 3). It would have been obvious to expand the shaped support to compensate for any irregularities and ensure that the shaped support is the appropriate size.

With regard to claim 5, Morlacchi teaches that the shaped support has an elastic or heat resistant coating (see lines 19-20 of page 3).

With regard to claim 7, Morlacchi teaches that the glue on the water-proofing sheath is present on the membrane before the membrane is attached to the shoe interior (see lines 27-29 of page 3).

With regard to claim 8, Morlacchi teaches that the glue pattern is made of several dots, which are discontinuous (see lines 4-6 of page 4).

With regard to claim 9, Morlacchi teaches that the membranes are semi-permeable (see lines 21-22 of page 4).

With regard to claim 10, Morlacchi teaches that the semi-permeable membrane is non-porous and carries out water vapor by osmosis (see lines 15-17 of page 4)

With regard to claim 11, Morlacchi teaches that teaches that the membranes are elastic (see lines 14-16 of page 4), and therefore the waterproofing sheath is implicitly coupled to an elastic fabric.

With regard to claim 51, Morlachi teaches that tapes may be used to affix the membrane to the inside (see lines 1-2 of page 5).

With regard to claim 52, Morlacchi discloses a process and device for waterproofing semi-manufactured articles (see title, as well as Abstract). Morlacchi teaches that a semi-manufactured with a three dimensional shape and an inner and outer surface (see lines 7-9 of page 3) is arranged onto a shaped support (see lines 18-22 of page 3). Morlacchi also teaches at least one waterproofing sheet with a layer of glue arranged between the sheet and the product is used to cover the product (see lines 27-30 of page 3). Morlacchi further teaches that the product, which is arranged around the shaped support, is water-proofed through pressing the waterproof sheet between two deformable pressing plates (see lines 16-19 of page 2, as well as Figures 6 and 7). Morlacchi teaches that the waterproof sheets are folded and flattened if they extend beyond the size of the semi-manufactured product (see lines 7-9 of page 2), and that after folding the sides adhere to one another to form at least two strips that seal the product during pressing (see lines 10-13 of page 2). Further, Morlacchi teaches that the glue on the water-proofing sheath is present on the membrane before the membrane is attached to the shoe interior (see lines 27-29 of page 3). While Morlacchi does not explicitly state that the waterproof sheets are shaped in a three-dimensional conformation similar to that of the product, the shape of the folded waterproof sheet

would implicitly be similar to the shape of the product and possess three dimensions. All objects with a length, width and height possess three dimensions, and the waterproof sheets inherently have a length, width and height. Additionally, as the waterproofing sheets are being placed on the product on the shaped support, the sheets would inherently have the same or similar shape to the semi-manufactured product. Morlacchi does not explicitly teach that the semi-permeable membrane is cut, folded, or welded together by superimposing two edges.

Polegato discloses a vapor permeable shoe and a method of making the vapor permeable shoe. Polegato teaches that a vapor permeable membrane is cut so that it is larger than the upper portion of the shoe (see lines 14-16 of column 4). The upper portion of the shoe is implicitly smaller than the entire inner surface of the shoe (see Figure 2), and since Polegato teaches that the membrane must be larger than the upper, the size to which the membrane is cut may implicitly be the size of the inside of the shoe. Polegato further teaches that the membrane is folded and that the edges are welded along the perimeter of the membrane (see lines 6-13 of column 4). When two edges are welded, a single sheet is implicitly formed, and it also implicitly has a third dimension. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the processes of Polegato in the process of Morlacchi. The rationale to do so would have been the motivation to provide an article that has an optimum internal microclimate (see lines 30-35 of column 1).

With regard to claim 53, Morlacchi discloses a process and device for waterproofing semi-manufactured articles (see title, as well as Abstract). Morlacchi teaches

that a semi-manufactured with a three dimensional shape and an inner and outer surface (see lines 7-9 of page 3) is arranged onto a shaped support (see lines 18-22 of page 3). Morlacchi also teaches at least one waterproofing sheet with a layer of glue arranged between the sheet and the product is used to cover the product (see lines 27-30 of page 3). Morlacchi further teaches that the product, which is arranged around the shaped support, is water-proofed through pressing the waterproof sheet between two deformable pressing plates (see lines 16-19 of page 2, as well as Figures 6 and 7). Morlacchi teaches that the waterproof sheets are folded and flattened if they extend beyond the size of the semi-manufactured product (see lines 7-9 of page 2), and that after folding the sides adhere to one another to form at least two strips that seal the product during pressing (see lines 10-13 of page 2). While Morlacchi does not explicitly state that the waterproof sheets are shaped in a three-dimensional conformation similar to that of the product, the shape of the folded waterproof sheet would implicitly be similar to the shape of the product and possess three dimensions. All objects with a length, width and height possess three dimensions, and the waterproof sheets inherently have a length, width and height. Additionally, as the waterproofing sheets are being placed on the product on the shaped support, the sheets would inherently have the same or similar shape to the semi-manufactured product. Morlacchi does not explicitly teach that the semi-permeable membrane is cut, folded, or welded together by superimposing two edges.

Polegato discloses a vapor permeable shoe and a method of making the vapor permeable shoe. Polegato teaches that a vapor permeable membrane is cut so that it

is larger than the upper portion of the shoe (see lines 14-16 of column 4). The upper portion of the shoe is implicitly smaller than the entire inner surface of the shoe (see Figure 2), and since Polegato teaches that the membrane must be larger than the upper, the size to which the membrane is cut may implicitly be the size of the inside of the shoe. Polegato further teaches that the membrane is folded and that the edges are welded along the perimeter of the membrane (see lines 6-13 of column 4). When two edges are welded, a single sheet is implicitly formed, and it also implicitly has a third dimension. Polegato further teaches that the membrane may be spot glued directly to the shoe interior (see lines 19-22 of column 6). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the processes of Polegato in the process of Morlacchi. The rationale to do so would have been the motivation to provide an article that has an optimum internal microclimate (see lines 30-35 of column 1).

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KEITH T. AZIZ whose telephone number is (571)270-7658. The examiner can normally be reached on Monday through Thursday 8:00am-6:30pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Katarzyna I. Wyrozebski can be reached on (571)272-1127. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/KTA/

/KHANH NGUYEN/

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